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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/698,368	10/30/2000	Ram B. Gupta	0318-332	5108

7590

07/11/2003

Cytec Industries Inc.
Patent Law Department
1937 West Main Street
P.O. Box 60
Stamford, CT 06904-0060

EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/698,368

Applicant(s)

GUPTA ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

#10

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/8.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to a telephone restriction with Attorney James A. Jubinsky on March 21, 2003.

The pending claims of record are claims 1-71.

Election/Restrictions

During a telephone conversation with Attorney James A. Jubinsky on March 21, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-71 directed to triazine compounds and compositions with said compounds. In replying to this Office action an affirmation of this election must be made. Claims 1-5, 12-15, 22-26, 33-37 and 42-71 directed to pyrimidine compounds are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-71, drawn to triazine compounds and compositions with said compounds, classified in class 544, subclass 3+.

- II. Claims 1-5, 12-15, 22-26, 33-37 and 42-71, drawn to pyrimidine compounds and compositions with said compounds, classified in class 544, subclass 242+.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use in a cosmetic compositions, coating compositions, photographic material or curable binders.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group I, restriction for examination purposes as indicated is proper. See MPEP § 806.05(d).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-71 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definition that "X is independently selected from a blocking group" in each of the formula II, III, IV and V of claims 1, 12, 22, 33, 42, 50, 54, 56, 57 and 58 appears to be indefinite when viewed in light of the instant specification at pages 3 and 19 for failing to describe or define the "blocking group of X".

The following phrases "or methane, and at least two Z are nitrogen," in line 1 and "or pyrimidine" in line 2 after formula II of claims 1, 42, 50, 54, 56, 57 and 58; in formula III of claims 12, 42, 50, 54, 56, 57 and 58; in formula IV of claims 22, 42, 50, 54, 56, 57 and 58; in formula V of claims 33, 42, 54, 56, 57 and 58; and in formula XXXXII of claim 71 render the instant claims indefinite and confusing because the phrases refer to the non-elected pyrimidine compounds. It is suggested that the said phrases should be deleted to overcome the rejection and so that the instant claims refer only to the elected triazine compounds.

The phrase "each Z is nitrogen;" in each of claims 11, 21, 32 and 41 render the claims indefinite in that it does not provides a further limitation of any previous claims. The said phrase should be canceled.

Claims 8, 18, 29 and 40 does not provide a further limitation of any previous claim and is indefinite. Each of the said claims should be canceled.

Claim 9 would be indefinite if it continues to depend from claim 8 that is required to be canceled. It is suggested that claim 9 should be made to depend form claim 1.

Claim 30 would be indefinite if it continues to depend from claim 29 that is required to be canceled. It is suggested that claim 32 should be made to depend from claim 23.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2 and 4-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gupta et al (Gupta) WO 00/14077, note Example 7 for compounds 5 and 6 found at page 35 for the 2-(2,4)-dihydroxyphenyl –4,6-bis (3,4-dimethylphenyl) –1,3,5 triazine that anticipates the instant claims.

Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gupta et al (Gupta) W 00/29,392, note page 57 for Part B of Example 63 for the 2-(2,4)-dihydroxyphenyl –4,6-bis (3,4-dimethylphenyl) –1,3,5 triazine that anticipates the instant claims.

Claim 71 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gupta et al (Gupta) W 00/29,392, note page 57 for Part A of Example 63 and page 58 for Comparative Example 63 for the 2- chloro -4,6-bis (3,4-dimethylphenyl) –1,3,5 triazine that anticipates the instant claim.

Claims 3 and 12-71 appears to contain allowable subject matter over the prior art made of record and would be allowed upon submissions of amendments to overcome

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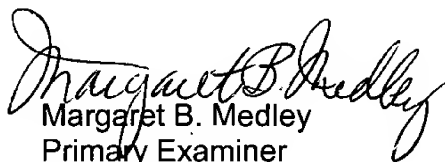
the 112 issues. Therefore, claims 3 and 12-71 are objected to with respect to the prior art made of record.

The prior art made of record and not relied upon are further teaches compounds and compositions of the same nature as those of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Margaret B. Medley
Primary Examiner
Art Unit 1714

MBMedley
July 9, 2003